

U.S. Appl. Serial No.:09/393,803
Merck Case No.:19188PCA
Page-10-

R E M A R K S

A Petition to Extend Time under 37 C.F.R. § 1.136(a) for one (1) month, up to and including 30 March 2005, is enclosed.

Claims 50-68 and 70-77 remain pending in this application. Claim 50 and claim 74 are further amended in response to the lone remaining rejection in this case. Applicants renew their position that amendment to these two independent claims does not add new matter. More specifically, claim 50 and claim 74 have been further amended to put rejected claims 50-63 and 74 in better condition for allowance, or alternatively, in better form for consideration during any possible appeal.

Rejection of Claims 50-63 and 74 Under 35 U.S.C. §112, First Paragraph

Claims 50-63 and 74 stand rejected under 35 U.S.C. §112, first paragraph as allegedly "failing to comply with the written description requirement." The Examiner takes the position that the "claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Claim 50 and claim 74 as previously amended recite a plasmid vector which encodes at least two and not more than three gene products. Applicants respectfully disagree with the Examiner's reasoning that this specific recitation adds new matter. Applicant's intention in regard to this recitation was not to add a specific limitation, but to instead succinctly claim this portion of Applicants invention. It is well documented throughout the specification that a preferred embodiment of the present invention is a plasmid DNA vector which co-expresses two or three distinct gene products subsequent to host introduction. Regardless of Applicants position, this present rejection is traversed by amendment to claim 50 and 74 to specifically recite what was previously intended: recitation of a plasmid DNA polynucleotide which is non-replicating upon *in vivo* introduction into a mammalian cell and induces the co-expression of either two or three gene products, depending upon the specific strategy utilized by the artisan. Claims 50 and 74 as currently amended find support throughout the specification. For example, in the SUMMARY OF THE INVENTION section alone, express support for currently amended claims 50 and 74 can be found as follows:

page 6, lines 2-4: "Nucleic acids, including DNA constructs and RNA transcripts, capable of inducing coordinate expression of two to three cistrons upon direct introduction into animal tissue, are presented."

U.S. Appl. Serial No.:09/393,803
Merck Case No.:19188PCA
Page-11-

page 6, lines 19-25: "These results are achieved with bi- or tri-cistronic nucleic acid polynucleotides encoding and co-expressing HIV gene products, immunostimulatory gene products including but not limited to GM-CSF, interleukins, interferon and B7 proteins, which act as T-cell costimulatory elements. The methods and polynucleotides of this invention are generally applicable to co-ordinate expression *in vivo* of any two or three genes."

Applicants respectfully take the position that current amendment to claims 50 and 74 puts traverses this §112, first paragraph rejection and results in all pending claims being in proper form for allowance. Withdrawal of this rejection and allowance of pending claims 50 - 68 and 70 - 77 is warranted and respectfully requested. The Examiner is invited to contact the undersigned attorney if clarification is required on any aspect of this response, or if any of the claims are considered to require further amendment to be placed in condition for allowance after entry of this Amendment.

Respectfully submitted,

Date: March 25, 2005

By: J. Mark Hand
J. Mark Hand
Reg. No. 36,545
Attorney for Applicant
Merck & Co., Inc.
P.O. Box 2000
Rahway, NJ 07065-0907
(732) 594-3905